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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,649	04/07/2004	Raymond G. Schuder	10002621 -2	8492

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P. O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

GATES, ERIC ANDREW

ART UNIT	PAPER NUMBER
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3722

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/15/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/820,649

Applicant(s)

SCHUDER ET AL.

Examiner

Eric A. Gates

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/7/06 and Interview Summary of 3/5/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-13, 21-30 and 36-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9, 10, 27-29, 36, 37, and 39 is/are rejected.
- 7) ☒ Claim(s) 11-13, 21-26, 30, and 38 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action replaces the office action mailed 12 February 2007 in its entirety.
2. This office action is in response to Applicant's amendment filed on 7 November 2006.

Claim Objections

3. Claim 39 is objected to because of the following informalities: the phrase "areas of the cover corresponding to" is repeated consecutively in the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 102/103

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made

Art Unit: 3722

to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 9, 10, 27-29, 36, 37, and 39 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Watson (U.S. Patent 3,847,718).

6. Regarding claim 9, Watson discloses a bookbinding system, comprising: a sheet binder (not shown, see column 4, lines 36-38) configured to bind two or more sheets into a text body 15 having an exposed spine bounded by two exposed side hinge areas (not labeled, see figure 3); an adhesive dispenser (in the form of a roll, not shown, see column 2, lines 63-67) configured to apply a solid pressure sensitive adhesive film 40 between a cover 32 (see column 3, lines 5-13, substrate 12 may be made of a width sufficient to form cover 32) and the side hinge areas of the text body 15; and a cover binder (not shown, see column 4, lines 38-46 and column 5, line 65 to column 6, line 2) configured to bind the cover to the side hinge areas of the text body by applying pressure to the cover.

It should be noted that the claim as currently written does not require the sheet binder and cover binder to be mechanically or automatically performed. However, in the alternative, it would have been obvious to have replaced a manual system for sheet and cover binding with an automatic system for the purpose of increasing production capability, as it has been held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to

Art Unit: 3722

distinguish over the prior art. In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958)

7. Regarding claim 10, Watson discloses wherein the adhesive dispenser is configured to apply a solid pressure sensitive adhesive film 40 to the cover in a series of spaced-apart strips (see figure 7).
8. Regarding claim 27, Watson discloses wherein the cover binder contacts the side hinge areas to the applied solid pressure sensitive adhesive film 40.
9. Regarding claim 28, Watson discloses wherein the adhesive dispenser dispenses the solid pressure sensitive adhesive 40 from a roll of solid sheet adhesive (the solid sheet adhesive that forms adhesive 40 is only a portion of the content of the roll).
10. Regarding claim 29, Watson discloses wherein the adhesive dispenser dispenses from the roll a solid sheet adhesive that comprises a pressure sensitive adhesive 40 composition dispersed on a carrier ribbon 18/19.
11. Regarding claim 36, Watson discloses further comprising a roll of the solid sheet adhesive loaded in the adhesive dispenser (the roll disclosed in claim 9 above is the adhesive dispenser).
12. Regarding claim 37, Watson discloses wherein the cover binder positions the cover over the exposed side hinge areas and the exposed spine of the text body 15 and applies pressure to the positioned cover 32 to activate the pressure sensitive adhesive film 40 (see column 5, line 65 to column 6, line 2).

Art Unit: 3722

13. Regarding claim 39, Watson discloses wherein the adhesive dispenser applies the spaced-apart strips of the solid pressure sensitive adhesive film 40 respectively over areas of the cover corresponding to the spine and the side hinge areas of the text body (see figure 7).

Allowable Subject Matter

14. Claims 11-13, 21-26, 30, and 38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

15. Applicant's arguments filed 7 November 2006 have been fully considered but they are not persuasive.

16. Applicant's arguments that "the text body defined in claim 9 is not formed until the two or more sheets are bound by the sheet binder" and "Watson does not teach or suggest an adhesive dispenser configured to apply a solid pressure sensitive adhesive film between a cover and the side hinge areas of the text body" do not overcome the rejection because the rejection of claim 9 points out "a sheet binder (not shown, see column 4, lines 36-38) configured to bind two or more sheets into a text body 15".

Column 4, lines 36-38 of Watson states "the loose pages comprising the book 15 are placed, edge first, on adhesive stripe 14". As disclosed by Watson, the text body 15 has already been formed by some form of sheet binder (even if this process has been

Art Unit: 3722

accomplished manually, the limitations of this portion of the claim have been met as the text body has been formed from separate sheets), and as such, two or more sheets have been bound (the term "bind" does not require a permanent binding of the sheets, therefore holding the sheets together into a text body by hand meets this limitation) into a text body 15 prior to an adhesive dispenser applying a solid pressure sensitive adhesive film 40 between a cover 32 and the side hinge areas of the text body 15.

17. Applicant's argument that "Watson does not disclose a sheet binder" has been addressed in the paragraph above.

18. Applicant's argument that "Watson does not disclose an adhesive dispenser" is not persuasive because there is no requirement in the claim that the adhesive dispenser (the roll of adhesive) apply the adhesive film without assistance from an additional mechanism (whether it be automatic or manual), only that the adhesive dispenser be "configured to apply a solid pressure sensitive adhesive film". As the claim states that the bookbinding system comprises a sheet binder, an adhesive dispenser, and a cover binder, there is nothing in the claim that prevents additional mechanisms from being present in the bookbinding system.

19. Applicant's argument that "Watson does not disclose a cover binder" is not persuasive because the cited portion of Watson (column 4, lines 38-46) distinctly states that "heat and pressure may then be applied, either simultaneously or in stages, to the bottom and sides of the substrate". Therefore Watson does disclose a cover binder that applies pressure to the cover.

Art Unit: 3722

20. Applicant's argument that "the Examiner has not explained how one skilled in the art at the time the invention was made would have been led to replace the unspecified manual system for sheet and cover binding with the unspecified automatic system" is not persuasive because "it has been held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art. *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). How one would have been led to automate a manual system for sheet and cover binding is well known in the art and is therefore not required as part of the rejection of the claim.

21. Applicant's argument that "Watson, however, does not teach or suggest anything about the way in which the pressure sensitive adhesive 40 is applied to the substrate 12" is not persuasive because this is not a limitation of the claim. Applicant's arguments that "Watson does not even hint that the pressure sensitive adhesive 40 is applied by the undisclosed adhesive dispenser" and "the disclosure does not describe an adhesive dispenser" are not persuasive because the roll is the adhesive dispenser, even if the adhesive is dispensed manually from the roll.

22. Applicant's argument that "Watson does not describe a cover binder. Indeed, Watson does not provide any details of the mechanism" is not persuasive because it is inherent that the cover binder would contact the side hinge areas to the applied solid pressure sensitive adhesive film, because Watson discloses that pressure is applied to the bottom and sides of the substrate to bond the pages to the cover.

Art Unit: 3722

23. Applicant's argument that "the Examiner impermissibly has relied on a single element of Watson's binding means 10 to meet the two separate and distinct elements of claim 19" is not persuasive because there is nothing in the claim preventing the carrier ribbon from being integral with the cover 32.

24. Applicant's argument that "Watson does not describe an adhesive dispenser" is not persuasive, because the roll is the adhesive dispenser.

25. Applicant's argument regarding claim 37 that "this disclosure does not even hint that this process is carried out by a cover binder of a bookbinding system" is not persuasive because even though the cover may be placed manually over the exposed side hinge areas, as provided for in the rejection of parent claim 9, the application of pressure by the cover binder would further position the cover over the exposed side hinge areas before the activation of the pressure sensitive adhesive film, as described in column 5, line 65 to column 6, line 2 of Watson.

26. For the reasons as set forth above, the rejections are maintained.

Conclusion

27. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

Art Unit: 3722

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric A. Gates whose telephone number is 571-272-5498. The examiner can normally be reached on Monday-Thursday 7:45-6:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



EAG
5 March 2007



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SUPERVISORY PATENT EXAMINER